



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

US.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/265,788	03/10/99	LU	R 08291/482001

┌

IM22/1014

└

ANDREW N PARFOMAK
FISH & RICHARDSON
45 ROCKEFELLER PLAZA
NEW YORK NY 10111

EXAMINER

GARRETT, D

ART UNIT	PAPER NUMBER
----------	--------------

1751

4

DATE MAILED: 10/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/265,788

Applicant(s)

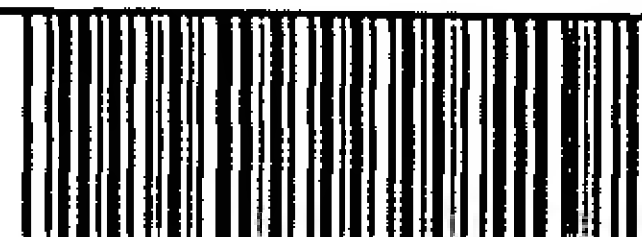
Lu et al.

Examiner

D. Garrett

Group Art Unit

1751



☒ Responsive to communication(s) filed on 3-10-99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1751

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of Great Britain 9807664.9 filed 4-14-98 has been received.

Claim Objections

2. Claims 1 and 10 are objected to because of the following informalities:

In line 14 of page 29, there should be a comma between "builder" and "0-5%wt." .

Claim 10 recites "at least one further nonionic surfactant", but claim 7 upon which claim 10 depends already recites "0.1 - 1-%wt. of at least one further nonionic surfactant". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are vague and indefinite due to the phrase "an effective amount"; this phrase is considered indefinite without designation of what the intended effect is in the claims

Art Unit: 1751

(see *Ex parte Dobson*, 165 USPQ 29 (PO BdApp 1969), *In re Frederiksen*, 102 USPQ 35 (CCPA 1954)).

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 (line 14) recites the broad recitation "conventional additives", and the claim also recites "particularly..." which is the narrower statement of the range/limitation.

6. Claims 3-5 recite the limitation "the at least one further nonionic surfactant". There is insufficient antecedent basis for this limitation in the claim. Claim 1 merely recites "0.1-10 % wt. of a nonionic surfactant".

7. The term "inventive compositions" in claim 1, line 18 and claim 7, line 24 is considered to be vague and indefinite. It is suggested that this phrase be changed to --composition--.

Art Unit: 1751

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Malik (US H269). The Malik et al. invention relates to a disinfectant and/or sanitizing cleaner composition which comprises water, a germicidal quaternary ammonium halide compound and a glycoside surfactant as well as additional ingredients (see abstract). Malik exemplifies a composition which anticipates instant claims 1-2 and 11 as shown in Table I, col. 8. Examples 1 and 2 contain 4.5 % quaternary ammonium halide, 4.5% glycoside surfactant, and water. The composition is applied to hard surfaces (see col 8, lines 1-30).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

Art Unit: 1751

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Evaluations of the level of ordinary skill in the art require consideration of such factors as various prior art approaches, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, and failure of others. The “person having ordinary skill” in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or admissions are considered to reasonably reflect this level of skill.

11. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richter (US 5,728,667).

Richter teaches germicidal light-duty dishwashing detergent composition in either a gel, liquid, or semi-liquid form, which comprises 0.5 - 2.75 parts quaternary ammonium germicidal compound (per instant claims 1, 2, 7, and 8), 10-40 parts by weight of a nonionic surfactant (per instant claims 1, 3- 5 and 9-11), 0.01 - 30 parts by weight of a suds boosting agent, and water (see abstract). Nonionic surfactants which may be used include block copolymers (see col. 8, line 4), primary aliphatic alcohol ethoxylates (see col. 8, line 14), alkylmonoglycosides and

Art Unit: 1751

alkylpolyglycosides (see col. 9, lines 54-67 and col. 10, lines 1-51). Also included in the composition may be detergency builder components per instant claims 7 (see col. 13, lines 53-65). Further optional components may include one or more surface active agents, chelating agents, sequestrants, coloring agents, solvents including alcohols, pH modifying agents, fragrances, fillers, and optical brighteners (see col. 12, line 61-col. 13, line 8) per instant claims 1 and 7. The Richter compositions include water added to the balance of constituents present so to provide 100% by weight of the concentrate composition (see col. 12, lines 49-53) per instant claims 1 and 7. Most preferably, the Richter composition is diluted in the range of 1:100 - 1:10,000 for use, but "the actual dilution selected is in part determinable by the degree and amount of dirt and grime to be removed from the surfaces and articles being cleaned, the amount of mechanical force..." (see col. 15, lines 41-58) per instant claims 6 and 10. The Richter composition are taught to be applied to hard surfaces (see col. 1, lines 15-19) per instant claims 11 and 12. Richter fails to teach a polymeric cationic surfactant based on a polyquaternary ammonium salt, however, as presently written, instant claims 1 and 7 recite this ingredient as optional. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have made compositions and practiced methods as recited in instant claims 1-12, because all limitations of these claims are generally taught by Richter.

Conclusion

Art Unit: 1751

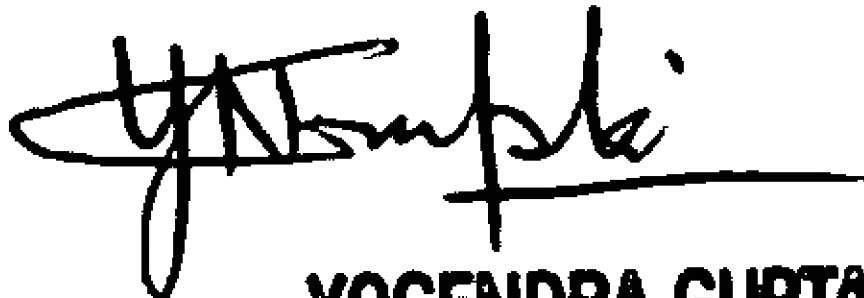
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references are considered cumulative to or less material than those discussed above.

US 5,880,076 teaches Mirapol A-15 as a suitable cationic polymer useful in personal product and detergent compositions.

13. Applicant is reminded that any evidence to be presented in accordance with 37 C.F.R. § 1.131 or 1.132 should be presented prior to final rejection in order to be considered timely.

14. Any inquiry concerning this communication or any earlier communications from the examiner should be directed to Dawn Garrett at (703)305-0788. The examiner can normally be reached between about 8:00 AM and about 5:30 PM, E.S.T., Monday through Thursday and alternate Fridays. If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached at (703)308-4708. The fax numbers for this Technology Center are:

- a. **(703)305-3599 -- FOR AFTER-FINAL FAXES ONLY, and**
- b. **(703)305-7718 -- FOR ALL OTHER OFFICIAL FAXES.** Any inquiry of a general nature or relating to the status of the application should be directed to the Tech. Center receptionist at (703)308-0661.


YOGENDRA GUPTA
SUPERVISORY PATENT EXAMINER



D.G.

October 5, 1999